

REMARKS

I. STATUS OF THE CLAIMS

Claims 167, 168, 171, 172, 174, 175, 177, 178, 180, 181, 185-191, 193-203, 205-208, 210-216, 218-228, 230-240, 242-245, 247-253, 255-258, 260-266, 268-278, 280, 290, 292-302, 304-307, and 309-311 are pending. No claims are amendeded herein.

Applicants acknowledge and appreciate that the Examiner has withdrawn the Section 112, second paragraph, rejection of claims 167, 168, 171, 172, 174, 175, 177, 178, 180, 181, 185-191, 193-203, 205-208, 210-216, 218-228, 230-240, 242-245, 247-253, 255-258, 260-266, 268-278, 280, 290, 292-302, 304-307, and 309-311.

II. INFORMATION DISCLOSURE STATEMENT

The Examiner states that the Information Disclosure Statement filed with Applicants' February 27, 2006, response was deficient and did not contain copies of the cited relevant references. Final Office Action, at p. 2. To fully comply with the Examiner's request, and to ensure that the Examiner consider the documents listed in the Information Disclosure Statement originally filed August 25, 2005, and which were resubmitted with Applicants' February 27, 2006, response, Applicants provide herein additional copies of the relevant references. Copies of Office Actions from copending applications are not submitted because they are available to the Examiner on the electronic PAIR system.

III. REJECTION UNDER 35 U.S.C. § 103(a)

The Examiner maintained the rejection of claims 167, 168, 171, 172, 174, 175, 177, 178, 180, 181, 185-191, 193-203, 205-208, 210-216, 218-228, 230-240, 242-245,

247-253, 255-258, 260-266, 268-278, 280, 290, 292-302, 304-307, and 309-311 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,019,377 to Torgerson ("*Torgerson*") in view of U.S. Patent No. 6,013,722 to Yang et al. ("*Yang*") for the reasons disclosed on pages 2-8 of the present Office Action. Applicants respectfully traverse this rejection for at least the reasons presented below.

Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 USPQ 467; see also *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007), slip op. at 2.

A. The cited prior art does not teach all the present claim limitations

Thus, in order to satisfy the initial burden of establishing a *prima facie* case of obviousness, the Examiner must first show that the prior art references teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In the present case, however, the rejection under Section 103 is fatally flawed at least because the combination of *Torgerson* and *Yang* fail to teach all the limitations recited in each of independent claims 167, 171, 172, 174, 175, 177, 178, 180, 181, and 309. As stated in the February 27, 2006, response, incorporated by reference herein in full,

each of the independent claims recites a composition that “provides a reshapable effect” to hair. A reshapable hair styling composition, as claimed in the present invention, is “a hair styling composition providing hair styling that can be restored or modified without new material or heat being applied.” Present Specification, at [0026]. In effect, the hair style is flexible such that it can move, with the ability to subsequently be returned to its original position. Neither *Torgerson* nor *Yang* discuss a composition that provides a reshapable effect anywhere in their disclosure.

To begin with, both *Torgerson* and *Yang* disclose compositions with adhesive properties. See, e.g., *Torgerson*, at Abstract (“The present invention relates to low glass transition temperature adhesive copolymers....”); see, e.g., *Yang*, at col. 1, line 5 (“This invention relates to pressure sensitive adhesives....”). The pressure sensitive adhesives in *Yang* “can be formulated to have a range of adhesive performance.” *Yang*, at col. 2, lines 55-56. Sample uses include producing adhesive coated sheet materials, such as, for example, labels, tapes, signs, covers, marking indicia, decals, and transfer tapes. See, e.g., *Yang*, col. 6, lines 29-41 and col. 7, lines 16-21. *Yang* is silent, however, as to any use of the claimed adhesives to provide a “reshapable effect” to hair.

Torgerson, on the other hand, discloses a hair styling composition that provides “styling hold.” *Torgerson*, col. 1, lines 12-15. Styling hold utilizes “adhesive copolymers” that assist in “hair *retain[ing]* a particular shape or configuration.” *Id.*, lines 21-23 (emphasis added); see *generally* col. 12, line 55 to col. 13, line 10 (discussing application of adhesive copolymers to achieve styling hold to hair). Although adhesive copolymers disclosed in *Torgerson* “allow[] the *perception* of continued naturalness

such as good hair movement and good hair feel,” this is not an instance where the hair style can be restored once present in a different setting, such as dishevelment.

Torgerson, at col. 2, lines 37-38 (emphasis added). Indeed, a commonly emphasized theme in *Torgerson* is that the styling hold achieved by the disclosed hair styling composition is a “temporary set style hold” which is “a temporary arrangement which can be removed by water or by shampooing.” See *id.*, col. 1, lines 29-31; see also *id.*, col. 2, lines 27-40.

Thus, in both *Yang* and *Torgerson*, adhesive materials are taught, whereas disclosure of compositions that provide reshapable effects, as defined in the present invention, are absent. Given this omission, Applicants maintain that the cited prior art does not disclose all the limitations of the present claims and that the Examiner is incorrect in stating that either of the prior art references provides a reshapable effect.

Nevertheless, the Examiner proceeds to state that “reshapable” denotes a physical property of a composition that “depends on the active components that make up the composition.” Office Action dated December 4, 2006, at 4-5. Given this assertion, the Examiner states that “[i]t would have been obvious to the skilled artisan that, the composition of the combined references, which comprise the surfactants of *Engel*¹ and the adhesive polymer of *Yang*, provides a reshapable effect on the hair as claimed by applicants.” *Id.*, at 6. As stated in the February 26, 2006, response, the Examiner provides no support for the conclusion that the combination of surfactants and adhesive polymers would provide a composition that would yield a reshapable hair

¹ It is Applicants’ understanding that the Examiner has withdrawn the rejection of the claims over the combination of *Engel* and *Yang*. Applicants request the Examiner to confirm Applicants’ assumption.

styling composition. Applicants respectfully submit that it is not enough for the Examiner to make such a conclusion without specific support.

The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. M.P.E.P. § 2112, quoting *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (emphasis in original). "In relying upon the theory of inherency, the *examiner must provide* a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (first emphasis added).

The Examiner's assertion that "'reshapable' denotes a physical property of the claimed composition [and] [w]hether a composition imparts reshapable styling effect on hair depends on the active components that make up the composition" clearly does not provide any evidence to support such an assertion. December 4, 2006, final Office Action, at 5-6. Applicants respectfully submit that a presumption that a property *might* be present, especially after the Examiner noted in the present Office Action that the cited references taught adhesive compositions, is not sufficient for a prima facie case of inherency. See *id.*, at 3 ("Torgerson teaches using low glass transition temperature (0-80 °C) adhesive polymers....") and at 4 ("Yang et al. teach a pressure sensitive adhesive emulsion....").

As a result, the Examiner has failed to provide sufficient evidence that any composition resulting from the combination of *Torgerson* and *Yang* would provide a reshapable effect. Accordingly, Applicants respectfully submit that the Examiner has

failed to establish a *prima facie* case of obviousness and respectfully request that the Section 103 rejections of claims 167, 168, 171, 172, 174, 175, 177, 178, 180, 181, 185-191, 193-203, 205-208, 210-216, 218-228, 230-240, 242-245, 247-253, 255-258, 260-266, 268-278, 280, 290, 292-302, 304-307, and 309-311 be withdrawn.

B. Consideration of the cited references as a whole do not result in the combination suggested by the Examiner

In order to satisfy the initial burden of establishing a *prima facie* case of obviousness, the Examiner must also show that there is some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). The Supreme Court, in the recent *KSR* case, recognized that a showing of “teaching, suggestion, or motivation” could provide helpful insight in determining whether the claimed subject matter is obvious under Section 103(a). *KSR*, slip op. at 14.

In addition, the Supreme Court mandates that “[t]o facilitate review, this analysis [of whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue] should be made explicit.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Federal Circuit, 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)).

Following the *KSR* decision, the Office issued a memorandum to its technology center directors on May 3, 2007, indicating that “**in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains**

necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” (emphasis in original).

In the present Office Action, the Examiner maintains the Section 103 arguments from the Office Action dated August 26, 2005. In doing so, the Examiner reiterates that all the elements of Applicants’ claims are taught by *Torgerson*. See Office Action dated December 4, 2006, at 3-4; see also *id.*, at 8 (“It is respectfully noted that applicants’ monomers are already taught by Torgerson.”). The Examiner then states that *Yang* assists with the selection of the specific monomers disclosed in *Torgerson* necessary to render the present invention obvious. *Id.*, at 8 (“Yang was cited merely to show that the specific selection out of the *Torgerson* monomers would have been obvious....”).

Applicants respectfully submit that the Examiner’s reasoning is flawed at least because it fails to take into account the teachings of the cited prior art as a whole. The Federal Circuit has held that a prior art reference must be considered in its entirety, and one may not “disregard[] disclosures in the references that diverge from and teach away from the invention at hand.” *W.L. Gore & Assocs., Inc., v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983); see also *Bausch & Lomb, Inc., v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986).

Thus, the Examiner must consider the entire disclosure of *Torgerson*, including those portions that are inconsistent with the Examiner’s asserted position. See *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (“a rejection cannot be predicated on the mere identification in [a prior art reference] of individual components of claimed limitations”). To begin with, *Torgerson* generally recites a hair styling composition

comprising a low glass transition temperature adhesive copolymer chain “where at least one of the monomer components is selected from acrylate amides and methacrylate amides; and furthermore at least one of the other monomer components is selected from acrylate esters and methacrylate esters.” See *Torgerson*, at Abstract; see also claim 1. A close examination of *Torgerson*, however, reveals that there is no specific disclosure of a copolymer composed of n-butyl acrylate, 2-hydroxy ethyl (meth)acrylate and 2-ethyl hexyl acrylate monomers, as claimed in the present application. Indeed, the Examiner states that “[*Torgerson*] lacks a specific exemplification of the preferred copolymer....” *Id.*, at 4.

To correct this omission, the Examiner cites to *Yang*, stating that *Yang* teaches, inter alia, “a pressure sensitive adhesive emulsion (cosmetically acceptable medium) comprising 50-90% n-butyl acrylate, 10-50% 2-hydroxy ethyl methacrylate, and 2-ethyl hexyl acrylate....” *Id.* The Examiner then argues that such a composition results in a low haze product and “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the hair styling composition of *Torgerson* by substituting the adhesive polymer [taught by *Torgerson*] with the adhesive copolymer comprising n-butyl acrylate/2-hydroxy ethyl (meth)acrylate/2-ethyl hexyl acrylate monomers as motivated by *Yang*.” *Id.*, at 5.

Applicants respectfully assert that, as with *Torgerson*, there is no specific disclosure of the claimed compound in *Yang*. To begin with, *Yang* discloses “[a] water resistant pressure sensitive adhesive... comprising (a) ...n-butyl acrylate, and ... (b) 2-hydroxy ethyl acrylate, or 2-hydroxy ethyl methacrylate, hydroxy propyl acrylate monomer, or mixtures thereof, (c) *optionally*, co-polymerizable monomers and (d)

optionally, a multifunctional cross-linking agent....” *Yang*, col. 3, lines 13-21 (emphasis added). *Yang* lists a large number of example co-polymerizable monomers with the result being an vast genus of compounds. *Id.*, at col. 3, lines 25-45. Moreover, *Yang* does not explicitly disclose an example of the claimed compound or a preferred sub-genera or species leading one to immediately envisage the claimed compound.

Thus, to obtain the present invention from the disclosure in *Yang*, one of skill in the art would therefore have to do an excessive amount of picking and choosing among *Yang*’s components. Without any clear guidance as to how to choose the specific components for the composition disclosed in the present invention, only through the utilization of the present specification and claims could one of ordinary skill in the art possibly have been guided to make the choices needed in an attempt to arrive at the subject matter recited in claims. This is not allowed. See M.P.E.P. § 2142 (“[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art”); see also *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991) (“Hindsight is not a justifiable basis on which to find that ultimate achievement of a long sought and difficult scientific goal was obvious.”).

As a result, the mere disclosure and combination of individual elements in prior art references does not establish obviousness. There must be some explicit reason presented that would have led one of ordinary skill in the art to combine those elements found in the prior art in the manner presented in the claims, else the rejection is improper. M.P.E.P. § 2143.01.

Additionally, it is important to note that *Torgerson* and *Yang* are directed to two different inventions. *Torgerson* requires a copolymer having a single glass transition temperature ranging from 0°C to 80°C and comprising at least one monomer selected from acrylate amides or methacrylate amides, and the necessary components that make up the compositions taught by *Torgerson* are both (1) acrylate- and methacrylate esters, and (2) acrylate- and methacrylate *amides*. See, e.g., *Torgerson*, at Abstract; col. 3, lines 20-30; claims 1 and 2. *Yang*, on the other hand, does not disclose such compounds with acrylate- or methacrylate amides. Rather, *Yang* discloses a pressure sensitive adhesive that comprises (a) n-butyl acrylate; (b) 2-hydroxy ethyl acrylate, 2-hydroxy ethyl methacrylate, or hydroxy propyl acrylate monomer; (c) optionally, copolymerizable monomers; and (d) optionally, a multifunctional cross-linking agent that exhibits less than 2% increase in haze, less than 2% increase in opacity and greater than approximately 95% transmittance in the visible spectrum ranging from 380 to 720 nm after wet lamination process. *Yang* at col. 2, lines 21-32.

Therefore, even assuming that the Examiner was able to pick the acrylate monomers recited in the present invention from the acrylate- and methacrylate esters disclosed in *Torgerson*, which Applicants in no way concede would occur, the Examiner would have to omit the acrylate- and methacrylate amides, while keeping the hair styling properties contained therein. This cannot be done. *Torgerson* requires a copolymer comprising at least one monomer selected from acrylate amides or methacrylate amides; monomers which are not required by *Yang*. Substituting a copolymer comprising units derived from n-butyl acrylate, 2-hydroxy ethyl (meth)acrylate and 2-ethyl hexyl acrylate monomers as disclosed by *Yang* for the copolymer of *Torgerson*

would omit an essential element, i.e., the acrylate- and methacrylate amides, of the composition of *Torgerson*.

The omission of an element from a reference and retention of its function is an indicia of unobviousness. *In re Edge*, 359 F.2d 896 (CCPA 1966); see M.P.E.P. § 2144.04(II). The acrylate- and methacrylate amides are essential components of the compounds disclosed in *Torgerson*. See, e.g., *Torgerson*, at Abstract; col. 3, lines 20-30; claims 1 and 2. Given the necessity of the amides to the compositions in *Torgerson*, it is not possible for *Yang* to rectify this error. For at least this reason, Applicants assert that the Examiner has failed to make a prima facie case of obviousness. Accordingly, these rejections under Section 103 are in error and should be withdrawn.

IV. CONCLUSION

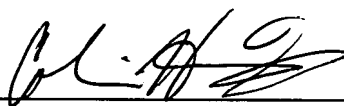
In view of the foregoing remarks, Applicants submit that this claimed invention is not rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: June 4, 2007

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